



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,431	08/05/2003	Wolfgang Guba	21152	8300
151	7590	10/20/2006	EXAMINER	
HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			STOCKTON, LAURA LYNNE	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/634,431	GUBA ET AL.	
	Examiner	Art Unit	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 29, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 11 and 13 is/are rejected.
- 7) ☒ Claim(s) 8,9,12 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1626

DETAILED ACTION

Claims 1-16 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 29, 2006 has been entered.

Rejections made in the previous Office Action that do not appear below have been overcome. Therefore,

Art Unit: 1626

arguments pertaining to these rejections will not be addressed.

Claim Objections

Claim 4 is objected to because of the following informalities: in claim 4, "cyclohexyl" is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1626

Claims 1-7, 10 and 11 are rejected under 35
U.S.C. 102(b) as being anticipated by:

A) CA Registry No. 339023-15-3 (May 30, 2001 -
entry date in Registry file on STN);

B) CA Registry No. 339023-11-9 (May 30, 2001 -
entry date in Registry file on STN);

C) CA Registry No. 339023-05-1 (May 30, 2001 -
entry date in Registry file on STN);

D) CA Registry No. 339023-03-9 (May 30, 2001 -
entry date in Registry file on STN);

E) CA Registry No. 339022-94-5 (May 30, 2001 -
entry date in Registry file on STN);

F) CA Registry No. 339022-92-3 (May 30, 2001 -
entry date in Registry file on STN);

G) CA Registry No. 339022-32-1 (May 30, 2001 -
entry date in Registry file on STN); or

H) CA Registry No. 339008-11-6 (May 30, 2001 -
entry date in Registry file on STN).

Art Unit: 1626

Each of the above CA Registry Numbers describes compounds embraced by the instant claimed invention. It is well within the skill of one skilled in the art to prepare each of the above compounds. For example, Lin et al. {Journal of Heterocyclic Chemistry, 16(7), pages 1377-1383, (1979)} teach a process of making 2-aminothiazole compounds (see Scheme 2b in column 2 on page 1377). See further Compounds IVe, IVf and IVg in Table 1 on page 1379. Lin et al. also teach that a number of 2-amino-4-(or 5-) thiazolyl phenyl ketones possessed moderate activity against *Mycobacterium tuberculosis* H37Rv infection (page 1378, column 2, first full paragraph). Therefore, each of the compounds cited above by their CA Registry Number are enabled and each anticipate the instant claimed invention.

Response to Arguments

Applicant's arguments filed September 29, 2006 have been fully considered but they are not persuasive.

Art Unit: 1626

Applicant argues that: (1) the CAS Registry entries do not enable Applicant's invention; (2) to be enabling, a prior art reference must enable one of ordinary skill in the art to practice the invention without undue experimentation; and (3) it is the Examiner's burden to make a *prima facie* showing that the public possessed Applicant's invention in order for a Section 102 rejection to be proper.

All of Applicant's arguments have been considered but have not been found persuasive. As stated above, it is well within the skill of one skilled in the art to prepare each of the above cited compounds. Lin et al. {Journal of Heterocyclic Chemistry, 16(7), pages 1377-1383, (1979)}, for example, teach a process of making 2-aminothiazole compounds (see Scheme 2b in column 2 on page 1377). Therefore, each of the compounds are enabled and was in the public's possession more than a year before the filing date of the instant claimed invention.

Art Unit: 1626

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. {Journal of Heterocyclic Chemistry, 16(7), pages 1377-1383, (1979)}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim thiazole compounds. Lin et al. teach thiazole compounds that are structurally similar to the instant claimed compounds. See formula (IV) in Lin et al., for example, the compounds in Table 1 on page 1379 and especially Compounds IVe, IVf and IVg.

Art Unit: 1626

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

The difference between the compounds of Lin et al. and the compounds instantly claimed is that of positional isomerism (see proviso in instant claim 1 and the *para* instead of *meta* position of the chloro group under the R₁ definition of Compound IVg of Lin et al.) .

Finding of prima facie obviousness--rational and motivation (MPEP

§2142-2413)

Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by Lin et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. In re Norris, 84 USPQ 458 (1950) .

One skilled in the art would thus be motivated to prepare positional isomers of the compounds taught by Lin et al. to arrive at the instant claimed products with the expectation of obtaining additional beneficial

Art Unit: 1626

products which would have activity against *Mycobacterium tuberculosis* H37Rv infection. The instant claimed invention would have been suggested and therefore, obvious to one skilled in the art.

Allowable Subject Matter

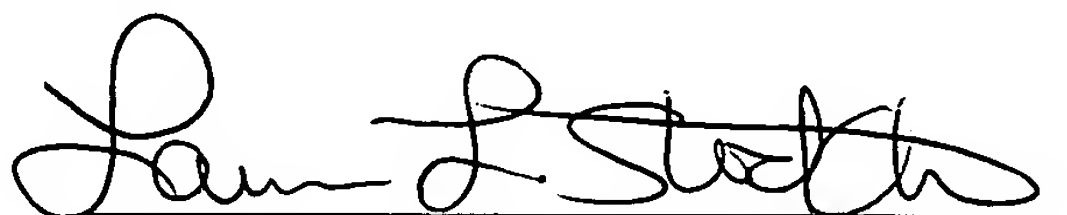
Claims 8, 9, 12 and 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

October 16, 2006